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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/773,741

02/06/2004

James DiMambro

60,629-001

8621

27305

7590

11/21/2006

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EXAMINER

NGUYEN, JENNIFER T

ART UNIT

PAPER NUMBER

2629

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,741

Applicant(s)

DIMAMBRO ET AL.

Examiner

Jennifer T. Nguyen

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura (Patent No. US 5,850,059) in view of Mitsuya (Pub. No.: US 2002/0021290).

Regarding claims 1 and 14, Yoshimura teaches a pointer (i.e., touch input pen 1, figs. 1A and 1B) assembly for identifying locations on a monitor, comprising:

an expandable member (8) having a distal end (16), wherein said distal end is enclosed by a tip (15) (col. 2, lines 23-33, col. 3, lines 7-13).

Yoshimura differs from claims 1 and 14 in that he does not specifically teach the tip having a durometer hardness selected to prevent scratching and marring of the monitor.

Mitsuya teaches an input tip having a durometer hardness selected to prevent scratching and marring of the monitor [0018]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the tip as taught by Mitsuya in the system of Yoshimura in order to protect the input screen and provide a pen capable of making a user feel pleasant.

Regarding claim 2, Yoshimura teaches said expandable member comprises a telescoping rod (col. 1, lines 36-37).

Regarding claims 3, 5, and 17, the combination of Yoshimura and Mitsuya teaches said tip comprises an elastomer [0018] of Mitsuya.

Regarding claims 4 and 16, the combination of Yoshimura and Mitsuya teaches said elastomer includes a durometer greater than generally 85 shore A hardness [0018] of Mitsuya.

Regarding claim 15, Yoshimura teaches elongated member is expandable between at least a first and a second length (col. 2, lines 23-33, col. 3, lines 7-13).

3. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura (Patent No. US 5,850,059) in view of Mitsuya (Pub. No.: US 2002/0021290) and further in view of An et al. (Patent No. US 6,771,254).

Regarding claims 6 and 7, the combination of Yoshimura and Mitsuya does not specifically teach said tip is injection molded onto said distal end.

An teaches a nib is injection molded onto said distal end (col. 5, lines 44-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the nib as taught by An in the system of the combination of Yoshimura and Mitsuya in order to retain and fit to the body of the pointer.

Regarding claims 8 and 9, the combination of Yoshimura, Mitsuya and An teaches said distal end is contoured thereby providing a tapered configuration to said tip that is coated (figs. 2 and 3 of An).

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura (Patent No. US 5,850,059) in view of Mitsuya (Pub. No.: US 2002/0021290) and further in view of Zigler (Patent No. US 5,747,748).

Regarding claim 10, the combination of Yoshimura and Mitsuya does not specifically teach said tip is shaped as an appendage of a human body.

Zigler teaches a tip of any shape (col. 2, lines 7-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the nib as taught by Zigler in the system of the combination of Yoshimura and Mitsuya in order to fit to different storage device.

5. Claims 11, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura (Patent No. US 5,850,059) in view of Mitsuya (Pub. No.: US 2002/0021290) and further in view of Wong et al. (Pub. No. US 2004/0127268).

Regarding claims 11 and 19, the combination of Yoshimura and Mitsuya does not specifically teach said distal end comprises a helical thread and said tip is adapted to receive said helical thread thereby releasably retaining said tip to said distal end.

Wong teaches a distal end (304) comprises a helical thread (308) and a tip (302) is adapted to receive said helical thread thereby releasably retaining said tip to said distal end [0019]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the thread as taught by Wong in the system of the combination of Yoshimura and Mitsuya in order to attach and detach the tip to the pointer easily.

Regarding claim 21, the combination of Yoshimura, Mitsuya, and Wong teaches a receptor affixable to the monitor and adapted to releasably receive said elongated member (fig. 1 of Wong).

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6. Claims 12, 13, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura (Patent No. US 5,850,059) in view of Mitsuya (Pub. No.: US 2002/0021290), Wong et al. (Pub. No. US 2004/0127268) and further in view of Slotta (Patent No. US 6,724,369).

Regarding claims 12, 13, 18, and 20, the combination of Yoshimura, Mitsuya, and Wong does not specifically teach "said tip comprises an insert ... said distal end".

Slotta teaches a tip (fig. 13) comprises an insert having a durometer hardness greater than a said durometer hardness of said tip and being adapted to receive said helical thread thereby releasably retaining said tip to said distal end (col. 14, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the insert as taught by Slotta in the system of the combination of Yoshimura, Mitsuya, and Wong in order to prevent the tip from deteriorating.

7. The prior art made of record and not relied upon is considered to pertinent applicant's disclosure: 6,273,627.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer T. Nguyen whose telephone number is 571-272-7696.

The examiner can normally be reached on Mon-Fri: 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Nguyen

11/15/06

A handwritten signature in black ink, appearing to read 'R. Hjerpe', is positioned above the printed name and title.

RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600